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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,476	06/07/2000	Dennis A. Carson	103.021US1	1184

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. BOX 2938  
MINNEAPOLIS, MN 55402

EXAMINER

JAGOE, DONNA A

ART UNIT PAPER NUMBER

1614

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/589,476

Applicant(s)

CARSON ET AL.

Examiner

Donna Jagoe

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,11,13,14,26-29,34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,11,13,14,26-29,34 and 35 is/are rejected:
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21 . 6) ☐ Other: .

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***Claims 1, 3-4, 11, 13-14, 26-29 and 34-35 are pending in this application.***

***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-4, 11, 13-14, 26-29 and 34-35 have been considered but are moot in view of the new ground(s) of rejection.

***Specification***

The specification is objected to on the following basis:

The brief description of the drawings provided at page 7 of the instant specification is incomplete insofar as a description of figures 8A, 8B, 8C and 8D (each is its own individual figure) is not provided.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-4, 11, 13-14, 26-29 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loma Linda University Medical Center WO 98/09603 A2.

The claims are drawn to a method to treat multiple myeloma comprising contacting mammalian cancer cells with an amount of a compound of formula (I) with dependent claims drawn to 1-R(-) etodolac, administered orally and also administering 1-R(-) etodolac to reduce the viability of multiple myeloma cells while maintaining the viability of normal bone marrow cells.

Loma Linda University Medical Center discloses the use of applicant's preferred compound, R(-) etodolac (page 9, line 9 bridging to page 10, line 30) to elicit a chemoprotective effect, wherein abnormal cell proliferation is reduced (page 7, lines 31-32) such that when co-administered to patients undergoing chemotherapy with other chemotherapeutic agents, it will increase the efficacy of those other agents (page 12, lines 23-25)

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It does not teach treatment of multiple myeloma specifically with R(-) etodolac. The prior art, instead teaches treatment of diseases of abnormal cell proliferation. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to administer R(-) etodolac to treat multiple myeloma motivated by the teaching of Loma Linda University Medical Center, who teaches that R(-) etodolac is employed for the treatment of diseases of abnormal cell proliferation since it is well known that multiple myeloma is a disease of abnormal proliferation of plasma cells.

Regarding the dosage recited in the instant claims, Dosages for cystic fibrosis are recites as from about 200 to about 2000mg (page 14, lines 23-30) with overlaps the doses of the instant application. As anyone of ordinary skill in the art will appreciate, preferred dosages are merely exemplary and serve as useful guideposts for the physician. There are, however, many reasons for varying dosages, including by orders of magnitude; for instance, an extremely heavy patient or one having an unusually severe disorder would require a correspondingly higher dosage. Furthermore, it is routine during animal and clinical studies to dramatically vary dosage to obtain data on parameters such as toxicity. The specific safe and effective amount will be vary, with such factors as the particular condition being treated, the physical condition of the patient, the duration of treatment, the nature of the concurrent therapy (if any), the specific dosage form to be used, the carrier employed, the solubility of the formula therein and the dosage regimen desired for the composition. For these and other self-evident reasons, it would have been obvious to have used 1000-5000mg of etodolac.

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Thus the claims fail to patentably distinguish over the state of the art as represented by the cited references.

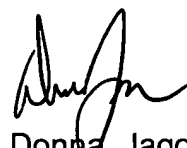
No claims are allowed.

### ***Correspondence***

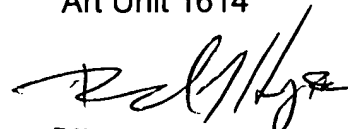
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna Jagoe whose telephone number is (703) 306-5826. The examiner can normally be reached on Monday through Friday from 8:00 A.M. - 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3230.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Donna Jagoe  
Patent Examiner  
Art Unit 1614



RAYMOND HENLEY, III  
PRIMARY EXAMINER  
GROUP 1000